

REMARKS

Claims 21 to 40 are pending.

I. 35 U.S.C. §112, SECOND PARAGRAPH REJECTION

The December 16, 2009 office action in this case, rejected claims 31 to 40 under 35 U.S.C. §112, second paragraph. The office action states:

Claim 31 identifies "a processing center" as a system component/structure. A "processing center" is reasonably interpreted to be a physical location where prescriptions are processed and further, the term "processing center" does not inherently denote specific hardware such that a machine or apparatus is reasonably defined. Accordingly, it is not clear what structure the recited "processing center" defines.

Office action page 3.

However, 35 U.S.C. §112, second paragraph does not require "specific hardware." The office action does not cite authority for a 35 U.S.C. §112, second paragraph "specific hardware" requirement.

35 U.S.C. §112, second paragraph, provides:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

And, whether claims are definite under 35 U.S.C. §112, second paragraph, is determined in light of the specification. The claims read in light of the specification need only apprise those skilled in the art of the scope of the invention. *Hybritech v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1387, 231 USPQ 81, 94, 95 (Fed. Cir. 1986), cert. denied 480 US 947 (1987).

The office action acknowledges that the specification and claims point out that a "processing center" is a "component/structure"- a machine or apparatus. See page 6 of the office action, quoted above. Certainly a location can be a structure. The term "processing center" is well-known in the art as an apparatus. See the 2591 issued patents from a "spec/"processing center" search of the USPTO database.

The “processing center” distinctly claims the invention and the rejection under 35 U.S.C. 112, second paragraph should be withdrawn.

II. 35 U.S.C. §101 REJECTION

Claims 21-30 are rejected under 35 U.S.C. §101.

The office action states at page 5:

While Examiner recognizes that the recited method steps refer to a “...processing center...”, a processing center” does not inherently denote a specific machine or apparatus. A processing center, is reasonably interpreted to be a physical location.

“Inherently denote a specific machine or apparatus” is an incorrect statement of law. Rather “[a] claimed process is surely patent eligible under § 101 if: (1) it is tied to a particular machine or apparatus...” *In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008). The claimed processing center is a “particular machine or apparatus” as abundantly defined in the claims themselves and in the specification and as acknowledged in the office action as pointed out in Applicant’s response to the rejection under 35 U.S.C. §112, second paragraph, above.

For these reasons, the 35 U.S.C. §101 rejection should be withdrawn.

III. 35 U.S.C. §103(a) REJECTIONS

Applicants’ October 30, 2009 Amendment canceled all claims and substituted claims 21 to 30 to a “prescription fulfillment method” and claims 31 to 40 to a “prescription fulfillment system.” The October 30, 2009 method claims recite “entering [a] filled and different medication brand or dosage into [a] processing center in fulfillment of [a] prescribed prescription” (the new method recitation). Further the Amendment added system claims to a processing center that “accepts filled prescription information through the network from the pharmacist in fulfillment of the prescribed information but that differs in at least one respect from medication brand or dosage of the prescribed prescription information” (the new system recitation).

The October 30 Amendment argued that:

The new claims claim an aspect of the invention relating to a system and method that admits of a pharmacist's discretion in filling a prescription. Prior art methods and systems (Denny, Keresman and Borsand [footnote omitted]) allow a pharmacist to enter a "yes" signal for a filled description that confirms filling of a prescription issued by a physician or medical provider. However, there are instances where a pharmacist should properly exercise discretion in filling the brand or dosage of the prescription. For example in instances, a pharmacist may fill a prescription with a generic rather than a prescribed name brand or with a dosage that is equivalent but different from prescribed dosage, e.g. 20 pills at half strength for 10 prescribed pills at full strength). However, prior art "yes" methods and systems do not provide for entering a filled description that is different with respect to brand or dosage.

Page 6 of October 30 Amendment.

A. 35 U.S.C. §103(a) METHOD CLAIMS REJECTION

The December 16, 2009 office action rejected claims 21 to 22 and 27 to 30 under 35 U.S.C. 103(a) over Denny Publication 2004/0107117 dated February 3, 2004 (Denny) and Borsand et al. Publication 20030074225 dated April 17, 2003 (Borsand) and rejected claims 23 to 26 over Denny, Borsand and Keresman III, et al. Publication 200110047281 dated November 29, 2001 (Keresman)..

First, Denny and Borsand are not prior art to Applicants' invention. Prior art for the purpose of 35 U.S.C. §103 (a) is defined by 35 U.S.C. §102. As relevant, 35 U.S.C. §102(a) provides that "a person shall be entitled to a patent unless the invention was ... described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent..." Borsand published April 17, 2003 and Denny published February 3, 2004 are not prior art to the instant March 3, 2002 filing. The rejections must be withdrawn.

In the same vein, the office action at page 7 states that "...as evidence by Borsand et al., it is well known in the prescription fulfillment art for the pharmacist to record or enter into a database, information regarding the specifics of a filled prescription including cost, drug type and quantity administered to the patient." The office action argues similarly at page 9.

While in 2010, this may be the case, it was not well known or suggested prescription fulfillment on *March 3, 2002*. And, Applicants vigorously dispute the page 7 statement “well known.” The office action fails to point out in a reference where any teaching or suggestion appears of “filling the prescribed prescription by a pharmacist, wherein the filled prescription is different from the retrieved prescription in respect of at least one of medication brand and dosage” (the new method recitation). The rejections of the method claims over Denny, Borsand and Keresman must be withdrawn.¹

B. 35 U.S.C. §103(a) SYSTEM CLAIMS REJECTION

The December 16, 2009 office action rejected claims 31 to 32 and 37 to 40 under 35 U.S.C. 103(a) over Denny and Borsand and rejected claims 33 to 36 over Denny, Borsand and Keresman.

First, the Denny and Borsand publications are not prior art to Applicants’ invention. The rejections must be withdrawn.

Also, the office action fails to point out where any teaching or suggestion appears in any reference of a processing center that “accepts filled prescription information through the network from the pharmacist in fulfillment of the prescribed information but that differs in at least one respect from medication brand or dosage of the prescribed prescription information” (the new system recitation).

To make out a *prima facie* case of obviousness, the PTO must show in the references (by column and line) the teaching that purportedly renders the invention obvious. See *In re Rijckaert*, 28 USPQ2d 1555, 1557 (Fed.Cir. 1993). If the PTO cannot point to express statements or implied suggestions of the claimed method or system invention in Borsand, then the rejections must be withdrawn. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

At page 7, the office action states:

¹ The examiner bears the burden of establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1555, 1556 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). “To establish a *prima facie* case of obviousness,... the prior art reference (or references when combined) must teach or suggest all the claim limitations,” MPEP 2143

However, as is evidenced by Borsand et al., it is well known in the prescription fulfillment art for the pharmacist to record or enter into a database, information regarding the specifics of a filled prescription including cost, drug type, and quantity administered to the patient. Accordingly, Borsand et al. teach a method wherein said filled prescription data includes information for said presented pharmaceutical type and said presented quantity and "wherein the filled prescription is different from the retrieved prescription in respect of at least one or medical brand and dosage..." (Borsand et al.; paragraphs [0005] [0040] [0056] [0064] [0086] [0118] *see electronic representation of filled prescription).

Applicants have searched Borsand for the quoted text material. It does not appear. Applicant has reviewed Borsand paragraphs [0005], [0040], [0056], [0064], [0086] and [0118] for any teaching or suggestion of "entering [a] filled and different medication brand or dosage into the processing center in fulfillment of [a] prescribed prescription..." (method recitation). No such teaching or suggestion appears. If the Patent Office disagrees, it must point out by column and line exactly where the relied upon disclosure appears or withdraw the rejections.

The rejections of claims 31 to 32 and 37 to 40 under 35 U.S.C. 103(a) over Denny and Borsand and claims 33 to 36 over Denny, Borsand and Keresman must be withdrawn..

IV. CONCLUSION

The December 16, 2009 office action is improper examination. The office action fails to point out where purported claim 21 and 31 teachings appear in the cited references. Failure to point out where purported teachings appear is improper examination.²

The Patent Office must withdraw the art rejections or point out where teachings or suggestions of the system recitation and the method recitation appear in the references.³

2 "[W]hen the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference...." In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed.Cir. 1993). See also 37 CFR 1.104 entitled "Nature of examination" providing that

In rejecting claims for want of novelty or for obviousness.... the particular part [of a reference] relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. 37 CFR 1.104 (c) (2).

3. MPEP 707.07, entitled "Completeness and Clarity of Examiner's Action,"

On January 6 and January 8, 2010 Applicants' representative called the Examiner in this case to inquire where the specific teachings relied upon by the Examiner appear in the references. The Examiner did not return the calls.

In view of the foregoing remarks, it is respectfully submitted that claims 21 to 40 are allowable. Reconsideration of this application and allowance are requested.

Should the Examiner believe that any further action is necessary in order to place this application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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provides that "[t]he examiner must address "all arguments which have not already been responded to in the statement of the rejection."